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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,587	08/07/2000	Geoffrey B. Rhoads	60258	3357

23735 7590 09/16/2003

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER

BURGESS, BARBARA N

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 09/16/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/633,587

Applicant(s)

RHOADS ET AL.

Examiner

Barbara N Burgess

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Mano.

As per claim 1, Mano discloses a document management method comprising:

- presenting a paper sheet to an optical sensor, the sensor producing scan data comprising document image data, the paper sheet having an optically-detectable indicia thereon, the indicia being machine readable but not generally intelligible to a human viewer thereof (column 1, lines 12-20, column 4, lines 5-10, 19-25, 30-35);
- processing the document image data to decode binary identification data represented by said indicia (column 5, lines 10-20);
- storing said document image data in a data store, wherein the document image data can thereafter be accessed from the data store by use of said binary identification data (column 2, lines 39-41, column 3, lines 40-42, column 4, lines 55-57, column 5, lines 1-5, 15-19);

- wherein a single scan of said paper sheet permits acquisition of both an image of the sheet for archiving, and identification data by which the stored image data can later be recalled (column 2, lines 39-41, column 3, lines 40-42, column 4, lines 55-57, column 5, lines 1-5, 15-19).

As per claim 8, Mano discloses the method of claim 1 wherein the identification data represented by the indicia comprises between 20 and 64 bits of binary information (column 4, lines 20-35).

As per claims 9, Mano further discloses the method of claim 1 wherein the indicia comprises a steganographic watermark (column 2, lines 35-40).

As per claim 10, Mano discloses the method of claim 1 wherein the indicia is formed on said sheet by ink jet printing (column 5, lines 1-35).

As per claim 11, Mano discloses the method of claim 1 wherein the optical sensor comprises an array of plural photosensor elements (column 5, lines 1-35).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2157

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mano in view of Crandall et al. (hereinafter "Cran", 5,782,494).

As per claims 2, 18, Mano does not explicitly disclose the method of claim 1 wherein the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof. However, the use and advantages of the paper sheet having adhesive on the other side is well known to one of ordinary skill in the art as evidenced by Cran (Abstract, column 3, lines 10-13).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate using an adhesive paper sheet in Mano's method in order for construction to pass through a personal computer printer without damage to the printer.

As per claims 3, Mano does not explicitly disclose the method of claim 2 wherein the adhesive note is a Post-It brand note. However, the use and advantages of using Post-It brand note is well known to one of ordinary skill in the art as evidenced by Cran (Abstract, column 3, lines 10-13).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate using Post-It brand note in

Art Unit: 2157

Mano's method in order for construction to pass through a personal computer printer without damage to the printer.

5. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mano in view of Phillips.

As per claims 4-7, Mano does not explicitly disclose the method of claim 1 that further includes:

- displaying data corresponding to said paper sheet on a computer screen.

However, the use and advantages of displaying data on a computer screen is well known to one of ordinary skill in the art as evidenced by Phillips (Abstract, column 1, lines 14-20).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate displaying the paper on a computer screen in Mano's method in order to view the scanned document after it has been stored on a data storage media.

As per claim 8, 17, 22, Mano discloses the method of claim 1 wherein the identification data represented by the indicia comprises between 20 and 64 bits of binary information (column 4, lines 20-35).

Art Unit: 2157

6. Claims 12- 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mano in view of Crandall et al. (hereinafter "Cran", 5,782,494) and in further view of Phillips.

As per claims 12, 15-16, 18, Mano does not explicitly disclose a method comprising:  
presenting an adhesive sticker to an optical sensor, the sticker having an optically-detectable, machine readable indicia thereon. . However, the use and advantages of the paper sheet having adhesive on the other side is well known to one of ordinary skill in the art as evidenced by Cran (Abstract, column 3, lines 10-13).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate using an adhesive paper sheet in Mano's method in order for construction to pass through a personal computer printer without damage to the printer.

Mano, in view of Cran, does not explicitly disclose displaying on a computer screen document data associated with said binary data. However, the use and advantages of displaying data on a computer screen is well known to one of ordinary skill in the art as evidenced by Phillips (Abstract, column 1, lines 14-20).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate displaying the paper on a computer screen in Mano's method in order to view the scanned document after it has been stored on a data storage media.

As per claims 13, 19, Mano does not explicitly disclose the method of claim 12 wherein the adhesive note is a Post-It brand note. However, the use and advantages of using Post-It brand note is well known to one of ordinary skill in the art as evidenced by Cran (Abstract, column 3, lines 10-13).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate using Post-It brand note in Mano's method in order for construction to pass through a personal computer printer without damage to the printer.

As per claim 14, Mano discloses the method of claim 12 in which said document data comprises a document image (column 1, lines 12-20, column 4, lines 5-10, 19-25, 30-35).

As per claims 17, 22, Mano discloses the method of claim 12 wherein said indicia represents between 20 and 64 bits of binary data (column 4, lines 20-35)..

As per claim 18, a sheet of note-paper, the sheet having tacky adhesive on one side thereof, the sheet further having an optically-detectable indicia thereon, said indicia being machine-readable but not generally intelligible to a human viewer thereof.



As per claim 20, Mano discloses a sheet according to claim 18 wherein the indicia is a steganographic digital watermark (column 2, lines 35-40).

As per claim 21, Mano discloses a sheet according to claim 18 wherein the indicia is a bar code (column 2, lines 35-40).

As per claim 23, Mano discloses a sheet according to claim 18 wherein the indicia is formed by printing (column 5, lines 1-35).

As per claim 24, Mano further discloses a sheet according to claim 23 wherein the indicia is formed by ink-jet printing (column 5, lines 1-35).

As per claim 25, Mano discloses a sheet according to claim 18 wherein the indicia is formed by texturing (column 5, lines 1-35).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Ettinene can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2157

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess  
Examiner  
Art Unit 2157

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ARJO ETIENNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100